

REMARKS/ARGUMENTS

Pending claims 9 – 12 and 23 – 26 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Application No. 2002/0137497 (Gillespie). Applicant respectfully traverses the rejection. With regard to claim 9, nowhere does Gillespie disclose a system that comprises a portable device separate from a telephone and connectable to a telephone line or a computer, as recited by amended claims 9 and 23. Instead, the system of Gillespie that caches calling name information is within a telecommunications network 28. Accordingly, for at least this reason claims 9-12 and claims 23-26 are patentable over Gillespie.

Claim 38 stands rejected under 35 U.S.C. § 103(a) over Gillespie in view of U.S. Patent No. 6,628,430 (Silverbrook). Applicant respectfully traverses the rejection, as neither reference teaches or suggests providing a printer and a portable device separate from a telephone and connectable to a telephone line or computer. Accordingly, claim 38 is patentable. For at least the same reasons as to claim 9 above, the rejections of claim 14 over Gillespie in view of U.S. Patent No. 5,970,133 (Salimando), claim 28 over Gillespie in view of U.S. Patent Application No. 2003/0063732 (McKnight), claims 13 and 29 in view of Gillespie alone, and claim 30 over Gillespie in view of U.S. Patent No. 6,324,396 (Vasa) are overcome.

Pending claims 9–12, 23–27, 30 and 39 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,697,484 (Fleming). Applicant respectfully traverses the rejection. As to claim 9, Fleming does not disclose a system that comprises a portable device separate from a telephone and connectable to a telephone line or a computer. Instead, the system of Fleming is a telephone itself. Nor does Fleming disclose an application that accesses a telephone number corresponding to an ongoing telephone call and search a database for a record containing a telephone number to display a name, telephone number and other information associated with the record. Accordingly, for at least these reasons claims 9-12 and 39 are patentable over Fleming. Claims 23–27 and 30 are patentable, as Fleming does not disclose a system that comprises a portable device separate from a telephone and connectable to a telephone line or a computer.

Further, for at least the same reasons discussed above with regard to the §102 rejection over Fleming, the §103(a) rejection of claims 13, 29, and 36 over Fleming alone is overcome, as is the rejection of claim 38 over Fleming in view of Silverbrook, and claims 14 and 28 over Fleming in view of McKnight.

As to the rejection of claims over European Patent Application No. 1,143,617 (Karves), Applicant respectfully submits that the Declaration under 37 C.F.R. § 1.131 previously filed (on February 12, 2004) removes it as a prior art reference. The Office Action states that evidence of diligence prior to September 28, 2001 is missing. However, such evidence is unnecessary to remove Karves as a reference, as diligence is only needed to be shown from a date immediately prior to the reference date.

As stated in 37 C.F.R. § 1.131(b), conception prior to the effective date of a reference “coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application” is all that is needed. Because the effective date of Karves is October 10, 2001, and the Declaration clearly shows diligence from September 28, 2001 until filing of the present application, the Declaration previously filed is sufficient to remove Karves as a reference.

To the extent that the Office Action states that certain claim language is missing from the evidence shown in Exhibit A to the Declaration (*see* Office Action, p. 2), such alleged missing evidence is irrelevant to removing Karves as a reference as to claims 9-14 and 38-39, as the purported missing claim language does not appear in those claims.


With respect to claim 23 and the claims depending therefrom, the purported missing claim language is present, as Exhibit A shows both an ability to search a local database and a remote database via the Internet. Further still, Karves does not disclose, at least, a portable device separate from a telephone and connectable to a telephone line or computer. Accordingly, even if Karves is considered to be a prior art reference, claims 23-26 are patentable over it.

Finally, the rejection of dependent claims 13, 14, 38 and 39 over Karves either alone or in combination with other references is improper, as Karves is not prior art to (at least) those claims. Furthermore, if Karves is considered a reference as to claims 27-30, such claims are patentable for the same reasons discussed above regarding claim 23.

In view of these remarks, the application is now in condition for allowance and the Examiner’s prompt action in accordance therewith is respectfully requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0694US).

Respectfully submitted,

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Mark J. Rozman
Registration No. 42,117
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, Texas 77024-1805
(512) 418-9944 [Phone]
(713) 468-8883 [Fax]



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